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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/462,387	04/19/2000	MARC DANIEL	A32851-PCTU	5025
21003	7590	08/30/2002	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			SHOSHO, CALLIE E	
ART UNIT	PAPER NUMBER			
1714		16		
DATE MAILED: 08/30/2002				

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/462,387	DANIEL ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	
<i>--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--</i>			
<p>THE REPLY FILED 19 August 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.</p>			
<u>PERIOD FOR REPLY</u> [check either a) or b)]			
<p>a) <input checked="" type="checkbox"/> The period for reply expires <u>5</u> months from the mailing date of the final rejection.</p> <p>b) <input type="checkbox"/> The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.</p>			
<p>ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).</p>			
<p>Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</p>			
<p>1. <input type="checkbox"/> A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.</p>			
<p>2. <input type="checkbox"/> The proposed amendment(s) will not be entered because:</p> <ul style="list-style-type: none"> (a) <input type="checkbox"/> they raise new issues that would require further consideration and/or search (see NOTE below); (b) <input type="checkbox"/> they raise the issue of new matter (see Note below); (c) <input type="checkbox"/> they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or (d) <input type="checkbox"/> they present additional claims without canceling a corresponding number of finally rejected claims. 			
<p>NOTE: _____</p>			
<p>3. <input checked="" type="checkbox"/> Applicant's reply has overcome the following rejection(s): <u>see attachment</u>.</p>			
<p>4. <input type="checkbox"/> Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).</p>			
<p>5. <input checked="" type="checkbox"/> The a)<input type="checkbox"/> affidavit, b)<input type="checkbox"/> exhibit, or c)<input checked="" type="checkbox"/> request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>see attachment</u>.</p>			
<p>6. <input type="checkbox"/> The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.</p>			
<p>7. <input type="checkbox"/> For purposes of Appeal, the proposed amendment(s) a)<input type="checkbox"/> will not be entered or b)<input type="checkbox"/> will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.</p>			
<p>The status of the claim(s) is (or will be) as follows:</p>			
<p>Claim(s) allowed: <u>None</u>.</p>			
<p>Claim(s) objected to: <u>23</u>.</p>			
<p>Claim(s) rejected: <u>13, 15-22 and 24-27</u>.</p>			
<p>Claim(s) withdrawn from consideration: <u>None</u>.</p>			
<p>8. <input type="checkbox"/> The proposed drawing correction filed on _____ is a)<input type="checkbox"/> approved or b)<input type="checkbox"/> disapproved by the Examiner.</p>			
<p>9. <input type="checkbox"/> Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.</p>			
<p>10. <input type="checkbox"/> Other: _____</p>			

Attachment to Advisory Action

1. Applicants' arguments filed 8/19/02 have been fully considered and are persuasive in overcoming and removing the rejections as set forth in paragraphs 2, 4, and 5 of the office action mailed 3/14/02, Paper No. 13. However, the arguments are not persuasive in overcoming the rejection set forth in paragraph 3 of the same office action, namely, the rejection of claims 13, 15-22, and 24-27 by Hojo (U.S. 5,939,493) in view of Jalics et al. (U.S. 5,708,053).

Applicants argue that there is no disclosure in either Hojo or Jalics et al. of improved hysteresis and reinforcing properties.

However, the present claims are drawn to a composition not a method of improving hysteresis loss and reinforcement properties. Given that the combination of Hojo in view of Jalics et al. disclose composition comprising ingredients as presently claimed, it is the examiner's position that the combination meets all the limitations of the present claims.

Applicants argue that Hojo places little emphasis on using an amine as an accelerator and that one skilled in the art would have found it far from obvious to infer from Hojo that an amine could improve hysteresis and reinforcement properties.

However, it is noted that col.9, lines 29-31 of Hojo disclose that a tertiary amine compound is "advantageously" used when silica (which is required in the present claims) is used as the reinforcing organic filler. Although there is no disclosure that using the amine will improve hysteresis and reinforcement properties, it is noted (i) there is no requirement for such an improvement in the present claims, (ii) even if such improvement were required in the present claims, given that Hojo disclose amine identical to that presently claimed, it is clear that such amine would intrinsically improve hysteresis and reinforcement properties, and (iii) col.9, lines

51-59 of Hojo disclose that the amine is used to improve resistance to aging and produce composition with good abrasion resistance. Although this motivation is not the same motivation for using amine as described in the present application, it is noted that obviousness under 103 is not negated because the motivation to arrive at the claimed invention as disclosed by the prior art does not agree with appellant's motivation, *In re Dillon*, 16 USPQ2d 1897 (Fed. Cir. 1990), *In re Tomlinson*, 150 USPQ 623 (CCPA 1996).

Applicants argue that the first sixteen examples of Hojo do not even contain amine.

However, it is noted that the first sixteen examples of Hojo do not use amine given that these examples disclose the use of carbon black and not silica as the filler and as set forth above, Hojo discloses that amine is advantageously used when silica is the filler. Examples 17-36 all of which utilize silica, all disclose the use of amine.

Applicants argue that it would not have been obvious to one of ordinary skill in the art to combine Hojo with Jalics et al. given that Jalics et al. is drawn to non-vulcanized rubber composition while Hojo is drawn to vulcanized rubber composition.

However, it is noted that col.8, lines 58-60 and col.9, lines 51-53 disclose that the rubber composition of Jalics et al. is in fact vulcanized.

Applicants argue that upon combining Hojo with Jalics et al., one would not know which accelerator to select given the comprehensive list supplied by Jalics et al. or whether to chose an aromatic or non-aromatic amine.

However, it is noted that Hojo disclose rubber composition comprising diene rubber, silica, silica coupling agent, and free aliphatic tertiary amine such as trioctylamine, but do not disclose the use of guanidine. Jalics et al., which is also drawn to rubber composition, is used for

its teaching of guanidine. Jalics et al. disclose the use of accelerator that is “preferably” guanidine (col.9, lines 15-18).

Applicants point to example 4 of the present specification and argue that the comparative data of this example establishes criticality over the cited prior art. Previously, examiner argued, as set forth in paragraph 6(f) of the office action mailed 3/14/02, Paper No. 13, that the comparative data does not show proper side-by-side comparison between composition of the present invention, i.e. comprising amine and guanidine (composition 19) and composition outside the scope of the present claims, i.e. comprising amine not guanidine (composition 17) given that composition 19 and composition 17 utilize different amounts of amine and thus the examiner cannot tell if the differences between the compositions are due to the presence of guanidine or to the difference in the amounts of amine. In response, applicants argue that compositions 17 utilizes the same molar amount of guanidine as the molar amount of amine utilized in composition 16 (which comprises guanidine not amine) while the comparison between compositions 18 and 19 show that using greater amounts of guanidine (as in composition 18) alone fails to reduce hysteresis as compared to using combination of guanidine and (aliphatic) amine.

However, it is noted that the “closest” prior art, i.e. Hojo, already disclose the use of aliphatic amine as required in the present claims but do not disclose the use of guanidine. Thus, in order to establish the criticality of using guanidine, proper comparison should be made between composition comprising amine and guanidine and composition comprising amine alone. Such comparison is not found when comparing compositions 16 and 17 or compositions 18 and 19. While applicant does compare composition of the present invention, i.e. comprising amine

and guanidine (composition 19) and composition outside the scope of the present claims, i.e. comprising amine not guanidine (composition 17), as set forth above, the examiner's position remains that given that composition 19 and composition 17 utilize different amounts of amine, the examiner cannot tell if the differences between the compositions are due to the presence of guanidine or to the difference in the amounts of amine, and thus, the data does not establish unexpected or surprising results over the cited prior art.

CS

Callie Shosho

8/28/02

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